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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,398	01/31/2002	Kunio Kotsuki	31238-177927	6077
26694	7590	03/26/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP			GRANT II, JEROME	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,398

Applicant(s)

KOTSUKI

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 5-1-02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. 09/089,162.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Detailed Action

Lacking Basis for Reissue

1. Claims 1-13 are rejected under 35 U.S.C. Sect. 251 as lacking basis for Reissue. By statute, a Reissue application can only be granted from the un-expired portion of the term of the original patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1983). Currently, no maintenance fees have been received.

Cross-Referencing

2. There is no cross-reference in the specification regarding the instant Reissue being a continuation from Reissue application series 09/089,162, which is now U.S. Pat. 6,020,974. Correction is required.

Certificate of Correction

3. Before Allowance, a Certificate of Correction is necessary to make reference of 10/059,398 in the U.S. Pat. 6,020,974.

Surrender of Original Patent

4. Applicant is required to surrender the original patent as required by 35 U.S.C.

251 (or) submit an affidavit/declaration averring that the original patent is lost or misplaced.

37 CFR 1.178. Original patent; continuing duty of applicant.

(a) The application for a reissue should be accompanied by either an offer to surrender the original patent, or the original patent itself, or if the original is lost or inaccessible, by a statement to that effect. The application may be accepted for examination in the absence of the original patent or the statement, but one or the other must be supplied before the application is allowed. If a reissue application is refused, the original patent, if surrendered, will be returned to applicant upon request.

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Warning Regarding New Matter

5. Applicant is advised that new matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251.

Defective Reissue Declaration

6. Claim 12 is rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth below. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion below.

In the Declaration, as it relates to claim 12, states:

“Claim 12 more explicitly recites a computer as part of the apparatus.”

This statement does not positively recite why they believe the patent to be wholly or partly inoperative or invalid. Inventors alleged that by reason of claiming more or less than they had the right to claim in the patent is the reason for the Reissue. However, no specific reason as to a defect, invalidation or inoperative state of claim 12 has been given. What was specifically not cited in the parent claim that needs to be corrected in the Reissue application ?

Claim 1 of parent case 09/089,162, recites “... central control means... for activating a personal computer...the telephone computer directory application software to access and display information stored in the computer...” Therefore, as for the examiner, claim 1 of the parent case sufficiently recites a computer in explicit terms.

7. Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,020, 974. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 1 refers to

“...controlling a serial communication with a personal computer,” verses

“..controlling a communication with a personal computer, according to claim 13 of the instant application.

The examiner submits that a "serial" communication is a type of communication that one of ordinary skill in the art would have been motivated to use to make applicant's invention with respect to the 974' patent. The serial communication is nonetheless a communication which is made to the computer and would have been contemplated by one of ordinary skill in the art.

Improper Recapture

8. Claims 7-12 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

Claims 7 –12 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.

In this Reissue Application, the decision from *Pannu v. Storz Instruments* (Fed. Cir. 2001) is being applied.

The court explained:

“The recapture rule ‘prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.’ Clement, 131 F.3d at 1468 USPQ2d at 1164. Reissue claims that are broader than the original patent’s claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. Mentor Corp. V. Coloplast, Inc 998 F.2d 992, 995, 27 USPQ 2d 1521, 1524 Fed. Cir. 1993). Application of the recapture rule is a three-step process. The first step is to ‘determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; Clement, 131 F.3d at 1470, 45 USPQ 2d 1165.”

Moreover, this court restated: A REISSUE CLAIM THAT DOES NOT INCLUDE A LIMITATION PRESENT IN THE ORIGINAL PATENT CLAIM IS BROADER IN THAT RESPECT. Hester, Id.

Based upon the ruling established in Pannu, the examiner will apply the ruling to the instant case.

FIRST STEP ANALYSIS

The first inquiry is to determine whether and in what aspect the Reissue claims are broader than the patent claims. Upon examination, it is determined that the Reissue claims are broader.

- a. Regarding claims 7 and 9 the aspect of determining the broadening of the Reissue claim is that by admission of the inventors, as stated in the Declaration, claims 7 and 9 does not require the interface. Hence claims 7 and 9 are broader.
- b. Regarding claim 11, the aspect of determining the broadening of the Reissue claim is that by admission of the inventors, as stated in the Declaration, claim 11 does not required the interface. Hence claim 11 is broader.
- c. Regarding claim 12, the aspect of determining the broadening of the Reissue claim is that this claim does not recite both the interface limitation as claimed and the line interface control means as claimed in claim 1. Hence claim 12 is broader.

SECOND STEP ANALYSIS

The second inquiry is to determine whether the broader aspects of the Reissued claim related to surrendered subject matter. (Note that the Hester decision, *Id.* stated in part: A reissue claim that does not include a limitation present in the original patent claim is broader in that respect). Upon further consideration, in the parent application, 09/089,162, upon which the REISSUE application is based, applicant filed an amendment received in the Patent Office on Sept. 8, 1999.

- a. Regarding claims 7 and 9, the amendment received Sept. 8, 1999 states among other things, adds "... transmitting through the interface the bell signal detection information for activating a telephone computer directory software in the personal computer, and 2) immediately after a time when the bell signal is received..." Hence, the interface limitation was identified in the FIRST STEP ANALYSIS above. The Sept. 8, 1999 amendment placed the application in condition for allowance. Hence, applicant surrendered the interface limitation (transmission thereby) in order to obtain the patent which issued as U.S. Pat. 6,020,974. Therefore, claims 7-10 are based upon improper recapture.
- b. Regarding claim 11, the amendment received Sept. 8, 1999 states among other things, "... transmitting through the interface the bell signal detection information for activating a telephone computer directory software in the personal computer, and 2) immediately after a time when the bell signal is received..." Hence, the interface limitation was identified in the FIRST STEP ANALYSIS above. The Sept. 8, 1999 amendment placed the application in condition for allowance. Hence, applicant surrendered the interface limitation (transmission thereby) in order to obtain the patent which issued as U.S. Pat. 6,020,974. Therefore, claim 11 is based upon improper recapture.

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c. Regarding claim 12, the amendment received Sept. 8, 1999 states among other things, "... transmitting through the interface the bell signal detection information for activating a telephone computer directory software in the personal computer, and 2) immediately after a time when the bell signal is received..." Hence, the interface limitation was identified in the FIRST STEP ANALYSIS above. The Sept. 8, 1999 amendment placed the application in condition for allowance. Hence, applicant surrendered the interface limitation (transmission thereby) in order to obtain the patent which issued as U.S. Pat. 6,020,974. Therefore, claim 11 is based upon improper recapture.

THIRD STEP ANALYSIS

The third inquiry is whether the REISSUED claims were materially narrowed in other respects to avoid the recapture rule.

a. Claims 8 and 10 recite the an interface for controlling a communication with the computer. While these claims are narrowed with respect to claims 7 and 9 of the instant case, they do not avoid recapture by reason of the second analysis.

b. Claim 11 further includes the limitation of : "...display means for displaying the relating information..." and " memory means for storing relating information corresponding to the telephone number information..."

This limitation qualifies claim 11 as being materially narrowed. But the question remains does claim 11 escape recapture although the two limitations are materially narrowed. The examiner opines that claim 11 does not escape recapture.

First, the display means for displaying information is executed by the "central control means" recited in the last paragraph of claim 1 of application 09/089,162. Furthermore, the memory means referred to here in claim 11 is set forth by the computer means also recited in the last limitation of claim 1 of application 09/089,162. Because the memory means and storage means have been previously recited in claim 1 of the parent application, claim 11 of the instant application " **is not narrowed in other respects.**"

c. Regarding claim 12, the recitation of the computer in the apparatus has already been recited in the last five lines of claim 1 of application 09/089,162. The computer which is referred to in claim 12 of the instant case is performing the same functions as the computer in claim 1 of the parent case. Claim 12 is not narrowed in other respects.

CONCLUSION

The examiner therefore, contends that based upon the three step analysis provided by *Pannu*, claims 7 and 8 are properly rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue was based.

9. Lack of Antecedent

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 refers to "...memory means for storing relating information..." However, there is no antecedent basis for "relating information". What information is being related ? What is the information being related to ?

Correction is required.

Spelling Abnormality

10. In claim 10, change "computer;" to –computer.–

Rejections Under Sect. 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7 –10 are rejected under 35 U.S.C. 102(b) as being anticipated by Archibald.

With regard to claim 7, Archibald teaches a communication apparatus shown by figures 1 and 2, comprising:

a line control means connected to a telephone line for conducting a line control operation including a dialing operation (CPU 210 in combination with off hook relay 260); a central control means (CPU 210); bell signal detecting means (digital signal processor 230) for detecting a bell signal received from the telephone line (or line 201 according to col. 5, lines 38-40) and outputting information of the detection- see also

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step 355 of figure 3; caller information detecting means (CPU 210) for detecting a caller telephone number notified to a call (see col. 5, lines 30-33) receiver by a caller telephone number notification service (211); central control means (210) for transmitting a bell signal (generally a series of dial tones or dial pulses) to transmit lead 232 for transmission, see col. 5, line 62- col. 6, line 3.

With respect to claim 8, Archibald teaches a DTE interface 270 for controlling communication with a personal computer 150.

With respect to claim 9, Archibald teaches a line control means connected to a telephone line for conducting a line control operation including a dialing operation (CPU 210); bell signal detecting means (terminal 110) for detecting a bell signal received from the telephone line (or line 201 according to col. 5, lines 38-40) and outputting information of the detection- see also step 355 of figure 3; caller information detecting means (CPU 210) for detecting a caller telephone number notified to a call (see col. 5, lines 30-33) receiver by a caller telephone number notification service (211); and a central control means (CPU 210) for initiating a request such as the application software (col. 3, lines 57-60 and col. 4, lines 45-50) initiation request for a computer 150 by means of a digital signal processor 230 and control means (CPU 210) transmits information of the detection from the off-hook detecting means (network 130) to director application initiation request means (220 for storing number of a caller list) to a computer (150). CPU 210 detects ring signals, see col. 6, lines 30-35 and detects and generates signals. See figure 2 . Archibald teaches transmitting a caller telephone

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number to a computer 150 as it is transmitted by means of DTE interface 270. See also col. 2, lines 52-54. Also the directory application request means is the signal (213) generated from CPU (210) to access caller party information stored in memory (220).

With respect to claim 10, Archibald teaches an interface DTE 270 for communicating with personal computer 150.

Rejection Under Sect. 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Archibald in view of JP 0913972A.

With respect to claim 11, Archibald teaches a line control means connected to a telephone line for conducting a line control operation including a dialing operation (CPU 210); a first detection means via bell signal detecting means (terminal 110) for

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detecting a bell signal received from the telephone line (or line 201 according to col. 5, lines 38-40) and outputting information of the detection- see also step 355 of figure 3; a second detection means via caller information detecting means (CPU 210) for detecting a caller telephone number notified to a call (see col. 5, lines 30-33) receiver by a caller telephone number notification service (211); memory means 220 for storing numbers relating to telephone numbers;

a central control means (CPU 210) for initiating a request such as the application software (col. 3, lines 57-60 and col. 4, lines 45-50) initiation request for a computer 150 by means of a digital signal processor 230 and control means (CPU 210) transmits information of the detection from the off-hook detecting means (network 130) to director application initiation request means (220 for storing number of a caller list) to a computer (150). CPU 210 detects ring signals, see col. 6, lines 30-35 and detects and generates signals. See figure 2 . Archibald teaches transmitting a caller telephone number to a computer 150 as it is transmitted by means of DTE interface 270. See also col. 2, lines 52-54. Also the directory application request means is the signal (213) generated from CPU (210) to access caller party information stored in memory (220).

What Archibald fails to teach is that the computer 150 specifically has a display to display services. It can be presumed that the computer 150 does have a display since a computer consists of at least a keyboard, control unit, processors, memory and a monitor. But assuming arguendo, Japanese publication 09139792A specifically shows a computer 2 with a display 36 for displaying services obtained from fax 1.

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Since Archibald and Japanese publication 0913972A are both directed to an image communication apparatus utilizing a computer, the purpose of a computer having a display would have been recognized by Archibald. It would have been obvious to one of ordinary skill in the art to replace the computer 150 of Archibald with the computer 2 shown by Japanese publication 0913972A for the purpose of displaying different services.

With respect to claim 12, Archibald teaches a computer 150 with a telephone directory application software (col. 3, lines 57-60 and col. 4, lines 45-50) initiation request for a computer 150 by means of a digital signal processor 230 and control means (CPU 210) transmits information of the detection from the off-hook detecting means (network 130) to director application initiation request means (220 for storing number of a caller list) to a computer (150).); a first detection means via bell signal detecting means (terminal 110) for detecting a bell signal received from the telephone line (or line 201 according to col. 5, lines 38-40) and outputting information of the detection- see also step 355 of figure 3; a second detection means via caller information detecting means (CPU 210) for detecting a caller telephone number notified to a call (see col. 5, lines 30-33) receiver by a caller telephone number notification service (211); memory means 220 for storing numbers relating to telephone numbers;

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a central control means (CPU 210) for initiating a request such as the application software (col. 3, lines 57-60 and col. 4, lines 45-50) initiation request for a computer 150 by means of a digital signal processor 230 and control means (CPU 210) transmits information of the detection from the off-hook detecting means (network 130) to director application initiation request means (220 for storing number of a caller list) to a computer (150). CPU 210 detects ring signals, see col. 6, lines 30-35 and detects and generates signals. See figure 2 . Archibald teaches transmitting a caller telephone number to a computer 150 as it is transmitted by means of DTE interface 270. See also col. 2, lines 52-54. Also the directory application request means is the signal (213) generated from CPU (210) to access caller party information stored in memory (220).

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Since Archibald and Japanese publication 0913972A are both directed to an image communication apparatus utilizing a computer, the purpose of a computer having a display would have been recognized by Archibald. It would have been obvious to one of ordinary skill in the art to replace the computer 150 of Archibald with the computer 2 shown by Japanese publication 0913972A for the purpose of displaying different services.

Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on (703) 305-4391. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

J. Grant II


JEROME GRANT II
PRIMARY EXAMINER